

REMARKS/ARGUMENTS

By this Amendment, amendments have been made to the specification and abstract in order to clarify certain parts of the description. The amendments of paragraphs [0048] and [0054] and the abstract are based upon the original German text of the parent International application, as attested to in the enclosed Declaration of Mr. Jeffrey D. Tekanic, and thus contain no new matter.

No amendments of the pending claims have been made and thus further examination of claims 11-33 filed with the Preliminary Amendment of May 23, 2006 is hereby requested in view of the following remarks.

It is first noted that the Examiner telephoned the undersigned on August 13, 2007 and requested several amendments of the claims in order to address written description concerns. However, no agreement was reached during the telephone interview and no Interview Summary has been provided to the undersigned.

In the non-final Office Action mailed August 15, 2007, claims 11-33 were rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the “written description requirement,” because the claims allegedly contain “subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.”

No rejection under 35 U.S.C. 112, second paragraph was made in the Office Action.

Before addressing the substance of these rejections, it is initially noted that the Applicants fully complied with the duty outlined in MPEP 2163(II)(A) when the Preliminary Amendment was filed, because express support in the original description (i.e. the original claims) for each of the new claims 11-33 was specifically identified at page 11 of the Preliminary Amendment. Applicants believe that the noted support for these claim amendments is clearly sufficient as it “is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification.” MPEP 2613(I).

Because the pending claims 11-33 are based upon the original claims 1-10, there can be no question that the Applicants had full possession of the claimed invention at the time that the parent International application was filed. In view of the fact that the original written description of original claims 1-10 undoubtedly supports the claims presented in the Preliminary

Amendment, it is clear the written description rejection made in the Office Action dated August 15, 2007 does not have a factual basis.

However, in order to facilitate understanding of the claimed invention with reference to the preferred embodiments, supplemental support for the pending claims in the specification and drawings will be identified herein. In this regard, it is noted that no prior art or lack of enablement objection has been made and thus no prosecution history estoppel effect is warranted by this recitation of support. Moreover, the claimed invention is not restricted to the preferred embodiment and Applicants must hereby emphasize and expressly state that nothing in this response should be interpreted as limiting the claimed invention in any way.

As the first ground for objection according to 35 U.S.C. 112, first paragraph, the expression “arranged and constructed” was criticized with the statement: “It is not clear what is the claimed limitation.”

However, the Examiner failed to “[e]stablish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.” MPEP 2163.01(III)(A).

Therefore, because a factual basis for this written description rejection was not elaborated in the Office Action dated August 15, 2007, the written description rejection has not been properly made and moreover, it is not presently understood how to respond to this particular statement made by the Examiner.

Without acquiescing to this written description rejection in any way, Applicants wish to note that the expression “arranged and constructed” is well-accepted claim terminology. A search of the PTO’s patent database (search term “arranged and constructed” in the field of “claim(s)”) identified at least 1379 issued US patents that have used this expression in the granted claims. In fact, at least three US patents (7,014,246, 6,450,561 and 6,142,542) appear to have been the responsibility of the present examiner.

Yet in spite of these facts, the Examiner has failed to identify any change in the law that would lead to a rejection in the present application. In other words, there is an absence of a clearly established factual and/or legal basis for imposing a Section 112 rejection in the present application, while the present Examiner has allowed three other patent applications with the same exact claim terminology.

In accordance with MPEP 2173.01, it is a “fundamental principle” that applicants are their own lexicographers. The expression “arranged and constructed” can be understood purely from the dictionary meanings of these terms. “Arranged” can be understood as meaning “disposed or placed in a particular kind of order” and “constructed” can be understood as meaning “formed”, “built” or “made”. For all intents and purposes, this expression can be broadly understand in the same way as the term “configured” when used in claims. In essence, these expressions are utilized to define a structure in terms of its properties. Thus, for example, the feature “rigid roof part” of claim 11 is understood as having the properties of being movable between a closed position, in which it extends between the windshield frame and the convertible top compartment lid (when the roof structure is mounted on a vehicle body), and an opened position, in which it is storable in a space underneath the convertible top compartment lid.

All pending claims have been thoroughly reviewed and it is believed that original description fully supports this terminology, which has been universally accepted as being appropriate claim terminology.

Therefore, the first ground for rejection under Section 112, first paragraph, should be withdrawn.

Next, the limitation “at least one guide element arranged and constructed to be supported on the convertible top compartment lid [or the vehicle body]” was identified and it was asserted that the guide element is not supported on the convertible top compartment lid.

Again, original claim 2 fully supports this feature. In addition, as a representative, non-limiting example, reference is made, e.g., to paragraph [0043], which states in pertinent part:

In the illustrated embodiment, it is formed by two roller pairs as guide elements, of which the first roller pair 40 is mounted on an arm that is immovable relative to the rear roof part (in Fig. 2, one roller 40 can be seen; the second roller of the roller pair is symmetrically provided on the roof part 16 with reference to the vehicle longitudinal middle plane). The second roller pair 42 is provided on the linkage mechanism 36 for opening and/or closing of the rear roof part 16.

In paragraph [0036], it was indicated that the “rear roof part” is constructed as the convertible top compartment lid 16. As can be seen in, e.g., Figs. 4, 6, 7, 9, 11, 12, 14, 15-18

and 20, the roller 40 (as a representative, non-limiting example of a “guide element”) is supported on the convertible top compartment lid 16. If necessary, further support for this feature can be found, e.g., in paragraphs [0046]-[0052], as well as the rest of the specification and figures.

Therefore, because the original claims and specification clearly provide support for “at least one guide element [that is] arranged and constructed to be supported on the convertible top compartment lid”, the second ground for rejection under Section 112, first paragraph, also should be withdrawn.

Next, the feature “a linkage mechanism arranged and constructed to move the roof part between the closed position and the opened position” was identified and it was alleged that the figures do not show the “linkage mechanism 35” connected with the roof.

The list of reference numbers provided on page 12 of the original description indicated that reference numbers 30 and 36 refer to linkage mechanisms. It is not presently understood why the pneumatic spring 35 alone would be identified as a linkage mechanism.

It is also noted that the English translation of original claim 1 inadvertently only recited reference number 36 after “linkage mechanism,” whereas the original German text of claim 1 and the abstract identified “(30, 36)” after the linkage mechanism. This typographical error is regretted and the Abstract as been amended in order to conform the English translation to the original German text.

With this correction in mind, it is again noted that original claim 1 provides more than adequate written description under Section 112, first paragraph, for this limitation. In addition, as a non-limiting example, reference is made to, e.g., paragraphs [0039]-[0040], in which linkage mechanism 30 is identified for moving the roof part 12 from the closed position to the opened (loaded) position. In the preferred, non-limiting example, linkage mechanism 30 includes the parts identified with reference numbers 31, 32 and 34. As can be seen in Figs. 2, 3, 6, 7, 9, 11, 12, 15, 17, 18 and 20, these parts provide a connection between the vehicle body and the roof part 12 and participate in the movement of the roof part 12 between the opened and closed positions.

Therefore, because the original claims, specification and drawings clearly provide support for “a linkage mechanism arranged and constructed to move the roof part between the

closed position and the opened position”, the third ground for rejection under Section 112, first paragraph, also should be withdrawn.

Next, the “guide device” limitation of claim 11 was recited in full and it was stated that “the guide device 33 does not contact the roof and therefore cannot guide the roof.”

It is again noted that, as was stated on page 11 of the Preliminary Amendment filed May 23, 2007, original claims 1 and 2 provide full support for this limitation in accordance with 35 U.S.C. 112, first paragraph.

In addition, it is not presently understood why only reference number 33 was identified as the “guide device” when original claim 1 identified reference numerals 40, 42, 44 as representative, not-limiting elements of a preferred guide device.

As a further non-limiting, representative example of written support in the present teachings for this limitation, reference is made, e.g., to paragraphs [0046]-[0052], in which paragraph [0046] indicates that a representative “guide device . . . is illustrated by the roller pairs 40 and 42”, paragraph [0047] indicates that a “guide path 44 [is] formed on the roof part [12]” (as well as making further reference to the “guide device”), and paragraphs [0048], [0051] and [0052] indicate the “directional changes” that are made by movement path of roof part 12 during the movement of the roof part 12 between its closed and opened positions.

In addition, paragraphs [0046], [0047] and [0050], *inter alia*, teach that the roller pairs 40 and 42 contact the guide path 44 during different segments or portions of the movement path.

Lastly, additional support for the guide device of claims 11 and 25, as well as the directional changes that take place, is provided, e.g., by paragraphs [0009] and [0054].

Therefore, because the original claims, specification and drawings clearly provide support for the last feature of claim 11, the fourth ground for rejection under Section 112, first paragraph, also should be withdrawn.

For all the foregoing reasons, it is believed that all of the written description rejections made in the Office Action of August 15, 2007 have been overcome and should be withdrawn.

In addition, all of the claims have been thoroughly reviewed and it is firmly believed that all pending claims fully comply with 35 U.S.C. 112 and no further amendments are required or warranted.

Therefore, it is respectfully requested to pass this application to allowance.

If the Examiner believes an interview, either telephonic or in person, will advance the prosecution of this matter, it is respectfully requested that the Examiner contact the undersigned at the Examiner's convenience.

Respectfully submitted,

Winfried Bunsmann et al.

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By:



Mark A. Ussai
Registration No. 42,195
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(215) 822-9104

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